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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,709	08/07/2006	Daniel Hinterman	DC10010 PCT 1	4484
137	7590	09/16/2010	EXAMINER	
DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994			KASSA, TIGABU	
ART UNIT	PAPER NUMBER			
			1619	
NOTIFICATION DATE	DELIVERY MODE			
09/16/2010	ELECTRONIC			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[patents.admin@dowcorning.com](mailto:patents.admin@dowcorning.com)

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,709	<b>Applicant(s)</b> HINTERMAN, DANIEL
	<b>Examiner</b> TIGABU KASSA	<b>Art Unit</b> 1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 June 2010.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 3-10 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### *Formal Matters*

Applicant's amendment filed on June 08, 2010 is acknowledged and entered.

**Claims 1 and 3-10 are pending.** Claims 1 and 3-10 are under consideration in the instant office action. Claim 2 is cancelled. Applicant's amendment has necessitated a new ground of rejection. Accordingly, this Action is FINAL.

Applicant's submitted declaration by Gary Wieber under 37 CFR 1.132 on 06/08/10 to antedate the secondary reference Schlosser (US 2004/0180011, IDS reference). Schlosser (US 2004/0180011, IDS reference) is no longer used in the rejections so applicant's declaration is considered moot.

### *Moot Rejections/Objections*

All rejections and/or objections over claim 2 cited in the previous office action mailed on June 08, 2010 are moot, because said claim(s) has/have been cancelled.

### *New Claim Rejections*

#### *Necessitated by Amendment Using Applied Prior Art of Record*

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 3-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Halloran et al (US Patent No. 5173290) (previously cited of record).**

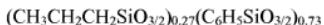
The instant rejection was previously made of record. However, after further consideration and in light of Applicant's Amendments to claim 1, claim 7, which was previously rejected under 35 USC 103(a) over Halloran (the instant reference) and a secondary reference, is found to be properly rejected under 35 USC 102(b).

Applicants claim a composition comprising a powder and an alkyl-phenyl silsesquioxane resin as the structure recited in the claim. The dependent claims thereof recite possible units that can be incorporated in the alkyl-phenyl silsesquioxane resin and additional components that can be added in the composition. Additionally, other dependent claims recite various products comprising the composition of claim 1.

Halloran et al. disclose composition prepared into a three neck round bottom flask equipped with a stirrer and thermometer by placing 39.8 grams toluene and 14.4 grams isopropanol, which are organic solvents. To this was added 33.6 grams phenyltrichlorosilane and 12.2 grams propyltrichlorosilane. Water was added to hydrolyze the chlorosilanes in an amount to produce an aqueous phase containing 13-16 weight percent hydrochloric acid. This mixture was refluxed for four hours insuring continuous hydrolysis. The hydrolyzate was separated from the aqueous phase, the solvent was removed under vacuum, and the solid product was flaked. The product corresponded to a nonpolar silsesquioxane of the formula  $RSiO_{3/2}$ . The examiner notes that applicants original specification disclose an example of the same reaction as described above in example 3, paragraph 0043, page 13 for the production of propyl-phenyl silsesquioxane, which is a species of the polymeric structure recited in instant

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claim 1. Based on the examiner's calculation in the example disclosed by Halloran et al.  $x = 12.2/45.8$ , which is 0.27, and  $y=33.6/45.8$ , which is 0.73. The overall structure of the product disclosed by Halloran et al. is as follows:



Additionally, Halloran et al. disclose the above described silsesquioxane was formulated into a hair fixative composition by mixing with ethanol (organic solvent) (column 5, lines 36-37). Halloran et al. also disclose that powders (thickeners) such as sodium alginate, starch etc., are included in the composition (column 13, lines 11-16). The examiner takes the position that the limitations recited in instant claims 8-10 are intended use of the composition disclosed in claim 1. The examiner reminds applicant that while instant claims 7-10 do recite different intended use labels descriptive of the product being claimed, there are no further structural limitations present other than the composition of claim 1. Therefore, the only structural component apparently necessary to meet the requirement of the claims is the composition of claim 1. Therefore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations. The examiner notes that the composition disclosed by Halloran et al. is capable of being used in the various products recited in instant claims 7-10 since it is the same composition as the instantly claimed composition. The above teachings clearly anticipate the limitations of instant claims 1 and 3-10.

***Response to arguments***

Applicant's arguments filed on 06/08/10 have been fully considered but they are not persuasive.

*Applicant argues that as stated by the Examiner, "Halloran et al discloses an alkyl-phenyl silsesquioxane resin in combination with powders, such as thickeners - sodium alginate, starch, etc. (column 13, lines 11-16)." And "Although Halloran et al clearly teach a personal care hair fixative composition comprising alkyl-phenyl silsesquioxane and powder, Halloran et al do not explicitly teach lipstick or foundation cosmetic composition. Halloran et al. also do not specifically teach that alkyl-phenyl silsesquioxane contains the units recited in instant claim 2".*

This is not found persuasive because in the alternative embodiment the examiner corrects the interpretation of the teachings of Halloran et al., for clearly anticipating amended instant claim 1 and also the limitation of claim 7. As per the claim amendment instant claim 1 recites that the values of a, b, c, and d could be zero. Under such conditions the teachings of Halloran et al., reciting the overall structure of the product as  $(\text{CH}_3\text{CH}_2\text{CH}_2\text{SiO}_{3/2})_{0.27}(\text{C}_6\text{H}_5\text{SiO}_{3/2})_{0.73}$  clearly meets the required claim limitation. The value of x + y equals 1 and the values of a, b, c, and d is zero. With respect to the limitation of instant claim 7 the examiner takes the position that the recitation is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitations.

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Applicant has not demonstrated how the claimed product is patentably distinct from the cited prior art nor do the claims as currently written distinguish the instant invention over the prior art. Therefore, instant claims 1 and 3-10 lack novelty to one of ordinary skill in the art at the time the invention was made, as evidenced by the reference, especially in the absence of evidence to the contrary.

**Conclusion**

Claims 1 and 3-10 remain rejected.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIGABU KASSA whose telephone number is (571)270-5867. The examiner can normally be reached on 9 am-5 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne P. Eyer can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tigabu Kassa

9/11/10

/Cherie M. Woodward/  
Primary Examiner, Art Unit 1647